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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,072	10/12/2004	Peter Kossler	SONN:056US	4856
32425 7590 07/31/2007 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			EXAMINER PRATT, HELEN F	
			ART UNIT 1761	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,072

Applicant(s)

KOSSLER ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-16, 19-23 and 26-47 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-12-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-16, 19-23, 26, 30, 32- 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (JP 58051880) in view of Schmidt et al. (British 1 520 738) and Takashi (0329701) and Asahi Chem. XP 002255668 and Chen (3,342,719).

Kobayashi et al. disclose a process of filtering fruit juice using ultrafiltration (abstract). Claims 13 and 14 differ from the reference in the use of pressed potato juice. Schmidt et al. disclose a process of treating potato water to remove protein. The starch is pressed out, and the fibers removed by centrifuge. The juice is then ultrafiltered (page 1, col. 2, lines 74-90, page 2, lines 32-50). Also, Takashi discloses that it is known to use potato milk from which starch and protein have been removed and to treat it with an anion exchange resin (abstract). Claim 13 further differs from the reference in that electrodialysis is used on the ultrafiltrate. Asahi Chem discloses a process of treating fruit juice by ultrafiltration, and electrodialysing the filtrate using an anion exchange membrane and mixing the concentrate of ultrafiltration and the acid removed filtrate (abstract). Chen discloses that it is known to use electrodialysis and an

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electrodialysis stack on juices (claim 30) (col. 1, lines 9-30). Therefore, it would have been obvious to use potato water and to use electrodialysis as shown by Chen et al. Ashi chem. in the process of Kobashi because it is known to use potato water in products and Takashi and Ashi Chem. disclose that it is known to remove acids and other and other substances from juices.

Claim 15 further requires that the electrodialysis be performed on the ultrafiltrate. Asahi Chem discloses that it is known to treat natural fruit juice by ultrafiltration, and then to electrodialyze (abstract).

Schmidt et al. disclose as in claim 16 that the concentrate obtained by UF is acidified, the protein removed, and the filtrate subjected to diafiltration and then spray dried. Drying can also be on drums (claim 19)(page 3, 25-30).

Claims 20 further requires adding a stabilizer to the potato juice, claim 21 an antioxidant, and claim 22, lemon juice. However, nothing new is seen in adding known ingredients to a composition for their known function. For instance it is well known that potatoes turn brown. Lemon juice is often used to reduce browning, and it is well known that the ascorbic acid of the juice is an antioxidant. Therefore, it would have been obvious to use known antioxidants for their known functions.

Nothing new is pressing more than one potato as in claim 23, as multiple vegetables are routinely process or in using particular varieties of potatoes absent a showing to the contrary as in claim 26.

Nothing new is seen in adding additional agents to a food product, which is seen as being within the skill of the ordinary worker as in claims 32-36. Each

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ingredient is used for its known function. Attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Therefore, it would have been obvious to add various ingredients to a food product for their known functions.

Claims 37 and 38 further require administering the claimed composition to a subject, which is a human. However, juice products are commonly given to humans and nothing new is seen in this. Therefore, it would have been obvious to administer a juice product to a human.

Claim 39 is to the product. The product has obtained by the method has been shown as above. Also, Claim 39 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796. also, Asahi chem. discloses a juice product made by electrodialysing the filtrate. Claim 39 differs from the reference in that a potato juice is used. However, as other ingredients of the juice have been removed, no patentable distinction is seen in the type of juice used, since they all contain varying degrees of the same constituents. Therefore, it would have been obvious to make a juice product as shown by the Asahi Chem or the combined references.

The particular amounts of organic components are seen to be in the composition since the method has been shown as in claims 40-42 and base and acid forming components as in claims 43-45.

Claims 46 and 47 further require administering the claimed composition to a subject, which is a human. However, juice products are commonly given to humans and nothing new is seen in this. Therefore, it would have been obvious to administer a juice product to a human.

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Claims 27-29, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above combined references as applied to the above claims, and further in view of Donovan et al. (6,440,222).

Claim 27 further requires an UF having a cutoff below 100 Da, claim 28 below 10,000, and claim 29, below 1,000. Donovan discloses that it is known to use UF on beet juice, which has various UF molecular weight cutoffs (abstract). Cut off's are disclosed as being 3,500 daltons (col. 11, lines 10-20, col. 12, lines 19-25). It would have been within the skill of the ordinary worker to determine the particular molecular weight cut off since this would determine the degree of filtration. Therefore, it would have been obvious to use known cutoff to make the claimed product.

Claim 31 further requires low diffusion membranes. However, it is seen that the membranes as in Donovan et al. are low diffusion membranes as they have particular molecular cutoffs. Therefore, it would have been obvious to use low diffusion membranes as disclosed by Donovan.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 is indefinite in the use of the phrase "low diffusion membranes". It is not known what is meant by the phrase or in the degree of diffusion of molecules.

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MISCELLANEOUS

"Product" in claim 13, line 4, should be – produce - .

Drawings

The specification should contain a section entitled "Brief Description of the Drawings". See MPEP 608.01(f).

ALLOWABLE SUBJECT MATTER

Claims 17, 18, 24-25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 7-27-07


HELEN PRATT
PRIMARY EXAMINER